

REMARKS

A. Claims 2 and 6 were objected to for containing informal deficiencies. The above amendment is believed to correct for those deficiencies.

B. Claims 1-19 were rejected under 35 U.S.C. §102(b) as being anticipated by Pond et al. (US 5,886,690). The applicant respectfully traverses this rejection for the following reason(s).

Pond et al. (*hereafter* : Pond) fails to anticipate the claims as originally filed and further fails to anticipate the claims as amended, the amendment being made in view of the objections raised in paragraphs 1 and 2 on page 2 of the Office action.

Note that in order for an anticipation rejection to be proper, the anticipating reference must disclose exactly what is claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Note here that the Examiner has not relied on "inherency," accordingly, each and every element must be expressly described in Pond.

Claims 1, for example, calls for *an input unit for inputting a display command for displaying a sub-list having a predetermined number of files selected in an entire list of the files recorded in a recording medium.*

Here, the Examiner refers to Pond's col. 5, lines 22-40, Fig. 2 and Fig. 5. Note also that the

Examiner erroneously equates Pond's "channels" with the claimed *files*.

Col. 5, lines 22-40 state: "Under another selected embodiment of the present invention, remote control unit 18 includes PAGE key 40 can be used to display a screen that allows the user to "page" forward, backward, up and down through various screens in a "page" mode. According to one aspect of the "page" mode, the up and down arrow keys will display only a selected subset of the available channels (i.e., ten (10) channels at a time) and the program screen guide includes a page bar for identifying the presence of any selectable program channels that are not present on the currently displayed channel bar. According to a separate aspect of the "page" mode when it is used while in the "Open Mode," the left and right arrow keys advance by a predetermined time interval (i.e., one day intervals) the portion of the available program schedule information that is displayed and the program screen guide includes a page bar for identifying the presence of any time-dependent program information for the program channels that is not presently shown on the program screen guide."

A review of the foregoing finds no mention of *an entire list of the files recorded in a recording medium*, and the Examiner has failed to identify where *a recording medium* is disclosed in Pond for recording Pond's "channels."

Looking further into the rejection, we find that the Examiner, on page 6, paragraph 16, with respect to claim 14, refers to Pond's ROM as the means for storing the *entire list* and further refers to Pond's RAM. We will address claim 14 later. As for now, we look back to claim 1 and read into the rejection reference to Pond's ROM or RAM as the claimed *recording medium*. The Examiner has made no mention of any other recording medium.

Looking to Pond's disclosure, we find, with respect to Fig. 10, the disclosed ROM and RAM.

Pond discloses "The main CPU 342 controls the overall operation of the IRD 16 by executing object code software stored in the read only memory (ROM) 351 and by both writing and reading data to and from the random access memory (RAM) 348." See col. 11, lines 17-20.

Accordingly, ROM 351 store only " object code software;" and being a read only memory can not store the "channel" information disclosed in Pond. That leaves us with RAM 348 to consider. Looking further to Pond's disclosure, we find no other mention of RAM 348 nor to what type of "data" that is stored therein.

Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Accordingly, the rejection of claim 1 is in error, because Pond fails to disclose, and thus anticipate, at least the claimed *entire list of the files recorded in a recording medium*. Thus the rejection should be withdrawn.

With respect to claim 10, it is required that Pond disclose a step of *reading an entire list of files recorded in a recording medium*. We find no factual reference to such a step being disclosed in Pond the rejection. The Examiner repeats the Applicant's claim language, identifies a portion of Pond's disclosure, *i.e.*, col. 5, lines 22-40, but fails to show where the above step is found in that portion of Pond's disclosure. Instead, the Examiner refers to a "control unit for inputting commands to display a sub-list, from the list of available channels." There is no indication that this "list of available channels" is entirely read, not that this list is recorded in a recording medium.

Accordingly, the rejection of claim 10 is in error and should be withdrawn.

With respect to claim 14, it is required that Pond disclose *detecting all the files recorded on said vast-capacity recording medium*.

The Examiner equated Pond's ROM 351 with the claimed *vast-capacity recording medium*. We can find no disclosure in Pond that ROM 351 stores Pond's entire list of available channels, and the Examiner has not pointed to any location in Pond supporting the rejection. Note, *Ex parte Levy*, 17 USPQ2d 1461, 1462 (1990) states:

"it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

We can only find that object code software is stored in the read only memory (ROM) 351.

Claim 14 also calls for *storing a list of said detected files in a storage unit separate from the vast-capacity recording medium*. Here, it appears that the Examiner is equating Pond's RAM 348 with the claimed *storage unit*. However, we can find no disclosure in Pond indicating that a list of files detected in ROM 351 is stored in RAM 348.

In Pond's only reference to RAM 348, Pond discloses "The main CPU 342 controls the overall operation of the IRD 16 by executing object code software stored in the read only memory (ROM) 351 and by both writing and reading data to and from the random access memory (RAM) 348." See col. 11, lines 17-20. There is no disclosure as to what the term "data" represents. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities.

Accordingly, the rejection of claim 14 is deemed to be in error and should be withdrawn.

Having shown that claims 1, 10 and 14 are not anticipated by Pond, it is thus deemed that the

rejection of claims 2-9, 11-13 and 15-19 is also deemed to be in error and should be withdrawn.

C. Claim 20 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Pond in view of van Zoest et al. (US 6,496,802) (*hereafter* : Zoest). The Applicant respectfully traverses this rejection for the following reason(s).

Claim 20 requires that *said files contain music data and are grouped according to a one of a song title, an album a song came from, an artist who did the song or a song's genre.*

The Examiner erroneously states that Pond teaches "the files consist of entertainment data," and refers us to Pond's col. 4, lines 5-8. Looking to the cited section of Pond we find disclosed therein:

VCR, AUX and TV in the control block illustrated by reference numeral 30. These various modes of operation allow a single remote control unit to operate a multiplicity of entertainment equipment. In each of the modes . . .

We find no mention of the word "files," nor the term "entertainment data" in the cited section of Pond. A search of Pond's disclosure finds no mention of the word "files," nor the term "entertainment data." It is the job of all PTO examiner's to present factual evidence, not make up terms to suit his or her need to make a rejection.

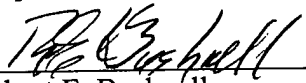
Additionally, Pond is directed to television and in particular an on-screen guide of television channels. One of ordinary skill in the art would have no motivation to look to Zoest's teachings of music data for modifying Pond or even combining the teachings of Pond and Zoest.

Accordingly, the rejection of claim 20 is deemed to be in error and should be withdrawn.

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendent, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,


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